

REMARKS

Claims 10-26 are pending. By this Amendment, no claims are cancelled, claims 10, 19, and 20 are amended, and no new claims are added. No new matter is introduced by the amendments.

In view of the following comments, Applicants respectfully request favorable consideration and prompt allowance of claims 10-26.

Rejection under 35 U.S.C. § 103(a) over Oleskevich and Tanuma

Claims 10-11, 13-15, and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,790,735 to Oleskevich et al. ("Oleskevich") in view of U.S. Patent No. 5,402,438 to Tanuma ("Tanuma"). The claims are not *prima facie* obvious over the cited references. Applicants respectfully request reconsideration of the rejection.

A *prima facie* case of obviousness of Applicants' claimed invention has not been established, as the cited references, individually or in combination, do not teach or suggest all of the features included in independent claims 10 or 19. "To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art." MPEP 2143.03. Specifically, the cited references do not teach or suggest an "output mirror [having] reflective properties for laser and pump radiation varying such that the output mirror reflects essentially all pump radiation as well as essentially all laser radiation falling on an inner region of said output mirror, said inner region of lower reflectance for the laser radiation, whereby said output mirror predominantly couples out low transverse modes" (claim 10) or an "output mirror [having] varying reflective properties for laser and pump radiation such that the output mirror reflects essentially all pump radiation and essentially all laser radiation falling on an inner region of said output mirror, said inner region of lower reflectance for the laser radiation, thereby coupling out low transverse modes, the method comprising activating said laser" (claim 19).

Thus, a *prima facie* of obviousness has not been established. Because the cited references to not teach all of the features of the claims, Applicants do not comment further here on the suitability of combining or modifying the cited references. Further, with respect to specific features of the claims depending from independent claims 10 and 19, these are not commented on further, as they are presently moot given the above analysis, although Applicants do not acquiesce in the Examiner's position. As such, Applicants respectfully request reconsideration of the rejection of claims 10-11, 13-15, and 17-19.

Rejection under 35 U.S.C. § 103(a) over Oleskevich, Tanuma, and Ohishi

Claims 12, 20, 22-23, and 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oleskevich in view of Tanuma and further in view of U.S. Patent No. 6,373,863 to Ohishi et al. ("Ohishi"). Ohishi does not make up for the deficiencies of Oleskevich and Tanuma discussed above with respect to claim 10, from which claims 12 depends. Further, the cited references do not teach or suggest an "output mirror [having] reflective properties for laser and pump radiation varying such that the output mirror reflects essentially all pump radiation and essentially all laser radiation falling on an inner region of said output mirror, said inner region of lower reflectance for the laser radiation, thereby coupling out low transverse modes," as included in claim 20, from which claims 22-23 and 25-26 depend.

Thus, a *prima facie* of obviousness has not been established. As such, Applicants respectfully request reconsideration of the rejection of claims 12, 20, 22-23, and 25-26.

Rejection under 35 U.S.C. § 103(a) over Tanuma and Waarts

Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanuma in view of U.S. Patent No. 4,995,050 to Waarts et al. ("Waarts"). Waarts does not make up for the deficiencies of Tanuma discussed above with respect to claim 10, from which claims 16 depends.

Thus, a *prima facie* of obviousness has not been established. Applicants respectfully request reconsideration of the rejection of claim 16.

Rejection under 35 U.S.C. § 103(a) over Oleskevich, Tanuma, Ohishi, and Shaw

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Oleskevich in view of Tanuma and Ohishi and further in view of U.S. Patent No. 4,634,282 to Shaw ("Shaw"). Shaw does not make up for the deficiencies of Oleskevich, Tanuma, and Ohishi discussed above with respect to claim 20, from which claims 21 depends. Thus, a *prima facie* of obviousness has not been established. Applicants respectfully request reconsideration of the rejection of claim 21.

Rejection under 35 U.S.C. § 103(a) over Oleskevich, Tanuma, Ohishi, and Waarts

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Oleskevich in view of Tanuma and Ohishi and further in view of Waarts. Waarts does not make up for the deficiencies of Oleskevich, Tanuma, and Ohishi discussed above with respect to claim 20, from which claims 24 depends. Thus, a *prima facie* of obviousness has not been established. Applicants respectfully request reconsideration of the rejection of claim 24.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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